

REMARKS

Reconsideration of above referenced application is respectfully requested. After entry of the instant office action response, Claims 1-3, 5-9, 11-13, 15-19, 21-23, 25-27 remain in the pending application. Please cancel Claims 4, 10, 14 and 20. Please add new Claim 27.

35 U.S.C. § 112, Rejection of Claims 3, 4, 9, 10, 13-15 and 17-21

The Examiner has rejected Claims 3, 4, 9, 10, 13-15 and 17-21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicant's attorney has canceled Claims 4, 10, 14 and 20 and drafted new claim 27 directed to a closure having first and second tiers. Applicants' attorney asserts that such amendment overcomes the Examiner's rejection and respectfully requests this ground of rejection withdrawn.

35 U.S.C. § 102(b), Rejection of Claims

The Examiner has rejected Claims 1, 5-7, 11, 12, 16, 22, 25 and 26 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,130,749 issued to Von Till. Applicants' attorney traverses the Examiner's ground of rejection.

The Examiner alleges that Von Till discloses Figs. 5 and 6, a molded closure comprising a principal thread and an auxiliary thread extending from substantially equivalent radial locations of a cylindrical wall; a depth of the principal thread being at least about twice a depth of the auxiliary thread; therefore, the auxiliary thread inhibits to engage with the container neck finish. The Examiner recites a portion of Ex parte Masham, which presumes that all of the claimed elements are shown, aside from the functional recitation. However, in this instance, that is not the situation.

As previously recited to the Examiner, anticipation "requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee." *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302 (Fed. Cir. 1995). "[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art

reference.” *Elan Pharms., Inc. v. Mayo Foundation for Medical Educ. & Research*, 304 F.2d 1221, 1227 (Fed.Cir. 2002).

Claim 1, requires that the closure require a first primary thread for engaging a container neck and a second auxiliary thread for engaging a more core and enable removal in case of a short shot condition. Irrespective of the Examiner’s position on functional limitations, Von Till fails to teach or suggest a primary (or principal) thread and an auxiliary thread. The Examiner alleges that numeral 14 thread. Contrary to the Examiner’s allegation, Applicants’ attorney reviewed the cited reference and ascertained from the specification that numeral 14 represents “a liner ledge or rib,” which “preferably merges with screw thread 6.” See page 2, Col. 4, lines 23-29. Thus, contrary to the Examiner’s allegation, Von Till does not provide a primary thread and an auxiliary thread as claimed by Applicants. Since the Examiner has failed to show all of the elements of the claimed invention, Applicants’ attorney does not need to address the Examiner’s position with respect to functional recitation, but reserves the right to do so in the future.

Further, the Examiner alleges that Von Till teaches “a depth of the principal thread being at least about twice a depth of the auxiliary thread.” To the contrary, aside from the reference failing to teach primary and auxiliary threads, Von Till fails to teach or suggest the claimed limitation of the primary thread having a depth twice the auxiliary thread.

Finally, Applicant’s attorney would also like to point out one additional problem with the Examiner’s rejection. Review of the Von Till reference also indicates that the closure taught therein “should be as short as possible,” as stated at page 2, Col. 3, lines 32-33. However, such construction teaches away from the design in the Applicant’s instant invention. Such short construction does not typically encounter the problem of short shots addressed by Applicants’ invention, and which is overcome by Applicants’ claimed invention.

Since Von Till fails to show all the elements of the claimed invention, Applicant’s attorney asserts that the Examiner’s rejection is improper. Applicant’s attorney respectfully requests this ground of rejection withdrawn.

35 U.S.C. § 103(a), Rejection of Claims 1, 2, 5-8, 11, 12, 16, 22, 23, 25 and 26

The Examiner has rejected Claims 1, 2, 5-8, 11, 12, 16, 22, 23, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Schmalz in view of Gibson (3,690,496). Applicants' attorney respectfully traverses the Examiner's instant rejection.

The Examiner alleges that Gibson discloses a principal helical thread and an auxiliary helical thread and that Schmalz teaches a closure having a depth of a principal thread being at least twice a depth of an auxiliary thread. Therefore, it would have been obvious at the time the invention was made to have a principal thread being at least about twice a depth of the auxiliary thread as taught by Schmalz in order to sealingly apply to a container having corresponding threads.

Applicant's attorney addressed this rejection with respect to Claims 25 and 26 in the previous office action. However, the Examiner has not addressed those arguments specifically but instead has merely added new claims to rejection and cited this as a new rejection. Applicants' attorney fails to understand the Examiner's procedure with respect to said response. In an effort to move prosecution forward, Applicants' attorney will address this rejection again in hopes that the Examiner will address these remarks.

First, the Examiner is reminded that the auxiliary thread is claimed "to inhibit engagement of the auxiliary thread and the container neck finish". The Examiner cannot summarily dismiss such limitation. The Examiner's statement that the closure would be applied to a container having corresponding threads is incorrect. As pointed out to the Examiner in the previous response, the auxiliary threads are not applied to the container.

As the Examiner should be aware, in rejecting claims under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. See In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q.2d 1955 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). Here the Examiner has not made a *prima facie* case of obviousness as to any of the rejected claims. A *prima facie* case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 26 U.S.P.Q.2d 1529 (Fed.

Cir. 1993); In re Rinehart, 531 F.2d 1048, 189 U.S.P.Q. 143 (C.C.P.A. 1976). Where the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This is not to say, however, that the claimed invention must expressly be suggested in any one of or all of the references. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 226 U.S.P.Q. 881 (Fed. Cir. 1985); In re Kaslow, 707 F.2d 1366, 217 U.S.P.Q. 1089 (Fed. Cir. 1983); In re Keller, 642 F.2d 413, 208 U.S.P.Q. 871 (C.C.P.A. 1981).

Here the applied references also are not combinable. It has been long recognized that references are not properly combinable where none of the cited references suggests the desirability of the inventive combination. See Application of Imperato, 179 U.S.P.Q. 730 (C.C.P.A. 1973) cited by the CAFC for the same proposition in In re Sernaker, 217 U.S.P.Q. 1 (Fed. Cir. 1983), and In re Gordon, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Further, prior art references must be considered in their entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). While a reference can be utilized for all that it teaches, focusing upon isolated portions of the reference or picking and choosing only that which supports a holding of obviousness is improper. Pertinent in this regard are also Panduit Corp. v. Dennison Mfg. Co., 1 U.S.P.Q. 2d 1593, 1602 (Fed. Cir. 1987) and In re Wesslau, 147 U.S.P.Q. 391 (C.C.P.A. 1965). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). That is not the case here.

In this instance, the Examiner's rejection is improper where there is no suggestion to make the cited combination because the Gibson and Schmalz references teach away from the Applicants' function and design. Specifically, Gibson teaches upper and lower threads which extend from a side wall of a closure. The thread depths are equivalent so that "when removing the cap, the bead interferes with the lower thread portion of the cap providing resistance to easy removal." The reference further teaches that the upper threads engage the upper thread of the

neck finish. Schmalz also teaches that upper threads engage the container neck. To the contrary, as recited in the instant claims, Applicants' auxiliary threads do not engage the container neck finish. Applicants' thread depth of the upper thread is half or less than that of the lower thread. Further, the upper and lower threads extend from the same radial location. Such claimed characteristic is not taught in the Gibson reference or the Schmalz reference and to allege such teaching, would change the function of Gibson rendering such device inoperable for its intended function. As the Examiner should be aware, this is improper.

Further, the Examiner's cited combination lacks suggestion for the combination since such combination would change the function of one of the cited references, rendering the device in said reference inoperable for its intended function. Since the Schmalz reference teaches that the upper threads are disposed along an upper wall and the lower threads are disposed along a lower side wall having a larger radial distance. As previously hinted, combining the Schmalz and Gibson references would inhibit the interference that is necessary for proper operation of the Gibson closure. Thus, the combination of references is improper because such combination improperly changes the intended function of said references rendering the devices taught therein inoperable. The Examiner is reminded that in making a combination, the Examiner may not change the function of a cited prior art reference. The Examiner is again directed to MPEP § 2143.01 which states "if a proposed modification would render the prior art invention being modified unsatisfactorily for its intended purpose, then there is no suggestion or motivation to make the proposed modification." See *In re Gorman*, 733 F.2d 900 (Fed. Cir. 1984).

Likewise, the Examiner's cited combination fails to show all of the elements of the claimed invention. The Examiner has stated that Gibson fails to teach a primary thread having twice the depth of the auxiliary thread. Likewise, Schmalz also fails to teach a primary thread having twice the depth the auxiliary thread. Instead, Schmalz teaches an upper thread and a lower thread wherein the upper thread has a fine pitch as compared to the lower thread. A fine pitch does not teach or otherwise suggest the limitation that the auxiliary thread be less than one-half the depth of the primary thread.

Further, the Schmalz reference fails to show threads extending from a radially equivalent positions or locations of a closure sidewall. Instead, the upper portion of the sidewall extends

radially inward and the upper threads extend from that inner bore in order to engage the container neck. The upper and lower offset bores of Schmalz teach away from threads which extend from radially equivalent locations. Thus, the Examiner's combination is improper because there is no suggestion to make the cited combination since such combination would modify the function of the cited prior art references rendering it inoperable. Moreover, the combination fails to teach all of the claimed limitations of the Applicants' pending claims since the cited combination is improper.

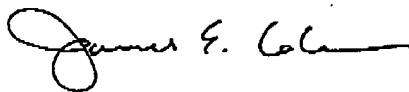
CONCLUSION

Applicants' attorney believes that the instant application is now in condition for allowance and therefore respectfully requests that the Examiner allow the pending claims. However, if the Examiner believes there are other unresolved issues in this case, Applicants' attorney of record would appreciate a call at (502) 584-1135 to discuss such remaining issues.

DATE: 11/14/05

Respectfully submitted,

MIDDLETON REUTLINGER



James E. Cole
Reg. No. 50,530
2500 Brown & Williamson Tower
Louisville, Kentucky 40202
PHONE: 502.584.1135
FAX: 502.561.0442
jcole@middreut.com